



1626
Atty. Dkt. No. 034536-0400
JFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Pen Cho TANG et al.

Title: PYRROLE SUBSTITUTED 2-INDOLINONE
PROTEIN KINASE INHIBITORS

Appl. No.: 10/081,147

Filing Date: February 25, 2002

Examiner: K. Saeed

Art Unit: 1626

RESTRICTION REQUIREMENT TRANSMITTAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is an amendment in the above-identified application.

The fee required for additional claims is calculated below:

	Claims As Amended	Previously Paid For		Extra Claims Present	Rate		Additional Claims Fee
Total Claims:	16	-	20	=	0	x	\$18.00 = \$0.00
Independent Claims:	2	-	3	=	0	x	\$88.00 = \$0.00
							First presentation of any Multiple Dependent Claims: + \$300.00 = \$0.00
							CLAIMS FEE TOTAL = \$0.00

Applicant hereby petitions for an extension of time under 37 C.F.R. §1.136(a) for the total number of months checked below:

<input type="checkbox"/>	Extension for response filed within the first month:	\$110.00	\$0.00
<input type="checkbox"/>	Extension for response filed within the second month:	\$430.00	\$0.00
<input type="checkbox"/>	Extension for response filed within the third month:	\$980.00	\$0.00
<input type="checkbox"/>	Extension for response filed within the fourth month:	\$1,530.00	\$0.00
<input type="checkbox"/>	Extension for response filed within the fifth month:	\$2,080.00	\$0.00
	EXTENSION FEE TOTAL:		\$0.00
<input type="checkbox"/>	Statutory Disclaimer Fee under 37 C.F.R. 1.20(d):	\$110.00	\$0.00
	CLAIMS, EXTENSION AND DISCLAIMER FEE TOTAL:		\$0.00
<input type="checkbox"/>	Small Entity Fees Apply (subtract ½ of above):		\$0.00
	TOTAL FEE:		\$0.00

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Please direct all correspondence to the undersigned attorney or agent at the address indicated below.

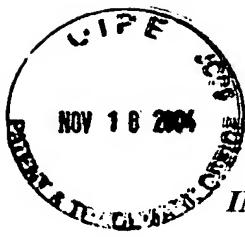
Respectfully submitted,

Date 11/16/04

By Cieve Burrous #46,785

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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the restriction requirement set forth in the Office Action mailed October 20, 2004, Applicants hereby provisionally elect Group I, Claims 1, 2, 4, 5, 9-12, 15 and 24, for examination, with traverse. Further, Applicants hereby provisionally elect for initial search and examination, the species of example 48 (3-[4-(3-Dimethylaminopropyl)-3,5-dimethyl-1H-pyrrol-2-ylmethylene]-1,3-dihydroindol-2-one) (*see* page 154 of the specification), with traverse.

The Examiner required restriction between Group I, Claims 1,2, 4, 5, 9-12, 15 and 24, drawn to products of the formula (I), classified in various subclasses of classes 514, 544, 546 and 548; and, Group II, Claims 16 and 18-22, drawn to methods of use for the compounds of the formula (I), classified in various subclasses of class 514. The Examiner also required where an election of Group I is made, an election of a single compound. Applicants respectfully disagree for the reasons discussed below.

a. **The Examiner Improperly Issued a Restriction Requirement at this Stage of Prosecution that is Nearly Identical to the August 26, 2002 Restriction**

It was improper for the Examiner to issue a restriction requirement that is nearly identical to the August 26, 2002 restriction requirement at this stage of prosecution. The prosecution history of this application is as follows:

- August 26, 2002: restriction requirement restricting the claims into a first Group directed to products of formula (I) and a second Group directed to methods of use for the compounds of formula (I)
- September 24, 2002: response to restriction requirement electing Group I (and the species of example 48).
- December 2, 2002: office action rejecting elected claims
- April 2, 2003: response to December 2, 2002 office action
- June 18, 2003: office action rejoining non-elected method claims
- October 20, 2003: response to June 18, 2003 office action
- November 14, 2003: notice of allowance allowing compound and method of use claims 1-5, 9-16, 18-22 and 24
- January 27, 2004: RCE and amendment containing clarifying amendments to the claims
- April 14, 2004: office action rejecting method claims for lack of enablement (compound claims 1, 2, 4, 5, 9-12 and 15 considered allowable)
- July 14, 2004: response to April 14, 2004 office action
- October 20, 2004: restriction requirement restricting the claims into a first Group directed to products of formula (I) and a second Group directed to methods of use for the compounds of formula (I)

As outlined above, all of the pending claims have been examined by the Examiner on the merits. On July 14, 2004, in response to the April 14, 2004 amendment in which the method of use claims were rejected for lack of enablement, Applicants submitted arguments addressing the Examiner's alleged lack of enablement rejection. Instead of properly considering Applicants' July 14, 2004 response and issuing a notice of allowance or an office

action providing reasons why the claims are not allowable, the Examiner improperly issued a restriction requirement that is nearly identical to the August 26, 2002 requirement.

It was improper for the Examiner to issue a restriction requirement because the method of use claims were already considered on the merits by the Examiner in the April 14, 2004 office action. By issuing a restriction requirement, the Examiner delayed the prosecution of this application and may have caused Applicants to lose a portion of their valuable patent term. Applicants respectfully request the Examiner to rejoin the claims of Groups I and II, consider Applicants' response filed July 14, 2004 and issue a notice of allowance or an office action providing reasons why the claims are not allowable in view of Applicants' arguments.

As stated above, the PTO has performed substantive examination on the entire application as evidenced by Office Actions dated December 2, 2002 and June 18, 2003, a notice of allowance dated November 14, 2003 and an Office Action April 14, 2004. By issuing a Restriction Requirement this late in prosecution, the Examiner has delayed issuance of the present application as a patent and as such, has shortened the potential patent term of the present application should it issue as a patent. The Examiner's attention is directed to 37 C.F.R. § 1.142(a), 2nd sentence states: “[i]f the distinctness and independence of the invention be clear, such requirement will be made before (emphasis added) any action upon the merits; however, it may be made at any time before final action in the case at the discretion of the examiner.” MPEP § 811 (following the above quote) further states, “This means, the examiner should, make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as a proper requirement develops (emphasis added).” This does not appear to have occurred in the present application.

Nothing has “developed” during the prosecution of the present application. Thus, according to MPEP 811, the Examiner has improperly issued a restriction at this stage in prosecution. Reconsideration and withdrawal of the restriction are respectfully requested.

b. Examining all of the Pending Claims Presents no Undue Burden on the Examiner

Applicants also traverse the Restriction Requirement because examining all of the pending claims presents no undue burden on the Examiner. According to MPEP § 803, “if a search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent and distinct inventions.” The Examiner is reminded that a species election is solely for search purposes and that should the elected species be free of the prior art, the Examiner will follow the procedure in M.P.E.P. 803.02 and extend the search to the other species.

CONCLUSION

The pending claims are in condition for allowance. An early notice to this effect is earnestly solicited. Should there be any questions concerning this application, Examiner Saeed is invited to contact the undersigned at the number listed below.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant(s) hereby petition(s) for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 11/16/04

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